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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,371

09/24/2003

G. William Ragland

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4796

7590

06/08/2004

ATD Corporation
Suite 300
255 Satellite Boulevard
Suwanee, GA 30024

EXAMINER

ZIMMERMAN, JOHN J

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,371

Applicant(s)

RAGLAND ET AL.

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

FIRST OFFICE ACTION

Preliminary Amendment

1. The Preliminary Amendment filed with this application has been entered. Claims 21-46 are pending in this application.

Information Disclosure Statement

2. No information disclosure statement has reached the application file as of the mailing of this Office Action.

Specification

3. The disclosure is objected to because of the following informalities: Applicant should update the status of each application in the parentage of this application at the beginning of the specification. Applicant must fill in the blanks in the specification (e.g. page 18, line 19). Appropriate correction is requested.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. The parenthetical matter (e.g. "0.15 mm") in the claims (e.g. claim 21, 28-32, 38, 45, 46) should be deleted since the metric unit of length and the English unit of length are not exactly equal and it is not clear which unit of length controls in the interpretation of these claims.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)

7. Claims 21-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent 6,660,403, U.S. Patent No. 5,939,212, U.S. Patent 5,958,603 or U.S. Patent 6,207,293. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patents require the same compression and interlocking structures required by the pending claims of this application. The inventive concept of using compression of a section of the multilayer foil structure to form valleys or interlocking regions in the structure is the same.

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 38-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa (Japanese publication 08-173823).

11. Ogawa discloses making multilayer metal foil structures comprising spacing corrugated foils and smooth foils by compressing the structures to form interlocking valley areas (e.g. see Figure 9, 10 and 14). Ogawa may differ from the claims in that Ogawa may not be intended to be an acoustical shield. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since the multilayer foil structure of Ogawa comprises spaced foils, it would inherently function to reduce noise even if Ogawa does not recognize such a property and this is not the intended use. The mere recitation of a newly discovered function or property, inherently possessed by things in the prior art does not cause a claim drawn to distinguish over the prior art. Since the alleged distinction between

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applicants' claims and the applied art is recited in the functional language, it is incumbent upon applicants to show that the article disclosed by the reference does not actually possess such characteristics, *In re Swinehart*, 169 USPQ 226 (CCPA 1971); *In re Ludtke*, 169 USPQ 563 (CCPA 1971). Ogawa may also differ from the claims in that Ogawa's foils may not be 0.006 inches thick. Ogawa, however, specifies metal foils for his invention and it would have been obvious to one of ordinary skill in the art to use foils of any commercially available thickness because this would only affect the weight, strength and cost of Ogawa's structure and would not impact his inventive concept of compressing the multilayer structures into rigid shapes. Selecting thicknesses of foils for Ogawa with regards to commercial availability, price, weight and strength would have been obvious to one of ordinary skill in the art at the time the invention was made because all these considerations are understood in the art to be relevant to economic and commercial success of catalyst carrier bodies.

Conclusion

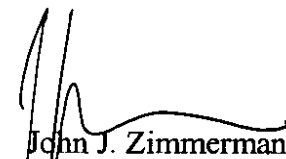
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This cited art serves to further establish the level of ordinary skill in the art at the time the invention was made. Note particularly that the use of interlocking configurations for multilayer foil structures is well known in the art (e.g. U.S. Patent 5,670,264 (Figure 8), U.S. Patent 5,385,790 (Figure 2)) and the compression of foils in regions is well known (e.g. U.S. Patent 2,045,733 (Figures 2, 3)). The prior art does not suggest or make obvious, however, the formation of a valley disposed between an uncompressed portion and compressed portion as recited in independent claims 21 and 30. Copies of the references cited on form PTO-892 have

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not been provided if the references were previously of record in either the parent applications or sibling application 10/112,726.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
May 27, 2004